

### **REMARKS**

In the Office Action, the Examiner objected to the drawings and specification; and rejected claim 1-4, 8-11, 22, 23, 25, and 26 under 35 U.S.C. § 103(a) as unpatentable over Applicant's Admitted Prior Art ("AAPA") taken together with U.S. Patent No. 5,587,342 of Lin et al. ("Lin").

Applicant has amended the specification to correct informalities and to conform the specification to the changes being made to the drawings. Applicant is also submitting herewith replacement sheets for FIGS. 3A-3D in which reference numeral "11" has been changed to --70-- and FIG. 6D in which reference number "31" has been changed to --32--. Further, Applicant has amended claims 1 and 8 to more appropriately define the invention, added new claims 27 and 28 to cover further aspects of the invention, and canceled non-elected claims 15 and 18. Claims 1-4, 8-11, 22, 23, and 25-28 are pending.

Applicant thanks the Examiner for the courtesy extended to his undersigned representative during the telephone interview conducted on June 4. The substance of that interview is documented by the Examiner's Interview Summary report dated June 4, 2004.

Applicant is submitting herewith a replacement sheet for Fig. 6D to change reference number "31" to --32-- to conform to the specification at page 18, lines 1 and 4.

Applicant is also submitting herewith replacement sheets for Figs. 5A-5D and 6A-6D to change reference number "40" to --26-- to conform to the specification at page 14, line 10-page 18, line 5.

In response to the Examiner's objection to the drawings and specification regarding the use of reference numeral 11, Applicant submits herewith Replacement Sheets for FIGS. 3A-3D on which reference numeral 11 has been changed to 70. Applicant has also amended the

specification at page 5 to conform to this change. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the objections to the drawings and specification.

Applicant respectfully traverses the Examiner's rejection of claims 1-4, 8-11, 22, 23, 25, and 26 as unpatentable over AAPA taken together with Lin. To establish a *prima facie* case of obviousness, each of three requirements must be met. First, the references, taken alone or combined, must teach or suggest each and every element recited in the claims. (*See* M.P.E.P. § 2143.03 (8th ed. 2001)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. *See id.* Third, a reasonable expectation of success must exist. *See id.* Moreover, each of these requirements must "be found in the prior art, and not based on applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001)).

With respect to the Examiner's application of the AAPA, Applicant respectfully submits that it appears the Examiner is combining the features disclosed in Figs. 1 and 2 as though they are part of the same prior art device. However, as explained in Applicant's specification, Fig. 1 illustrates a "resin encapsulating apparatus for sealing a resin with the use of a given amount extruding method." (page 2, lines 13-15) In contrast, in Fig. 2 illustrates a "resin encapsulating apparatus for performing resin sealing by a printing method." (page 3, lines 17-19)

Figs. 3B-3D of the AAPA, also relied on by the Examiner, only relate to the apparatus shown in Fig. 2. There is no basis for selectively combining the features of the two distinct apparatuses respectively shown in Figs. 1 and 2. As a result, the Examiner has not established a *prima facie* case of obviousness.

Nevertheless, to advance prosecution, Applicant has amended independent claims 1 and 8 to each recite a resin encapsulating apparatus comprising a combination of elements including “an extruding section configured to extrude a fluidizing resin in an extruding direction into the opening of the mask,” and “a squeegee which causes a movement of the fluidizing resin present over the opening which is extruded from the extruding section into the opening, an interval between the extruding section and the squeegee being set to be wider than a length of the opening in the extruding direction.” As discussed in the interview with the Examiner, amended claims 1 and 8 overcome the rejection under § 103(a). Applicant therefore submits that independent claims 1 and 8 are patentable. Applicant has also added new independent claims 27 and 28 that recite features generally corresponding to claims 1 and 8, respectively. However, new claims 27 and 28 recite a resin encapsulating apparatus including “an interval between the extruding section and the squeegee being set to be shorter than a length of the opening in the extruding direction.” This feature is supported in Applicant’s specification at, for example, page 16, lines 17-23. Since new claims 27 and 28 recite features generally corresponding to patentable claims 1 and 8, Applicant submits that claims 27 and 28 are also patentable.

In view of the above-amendments and remarks, Applicant submits that the pending claimed are in condition for allowance. A favorable action is requested.

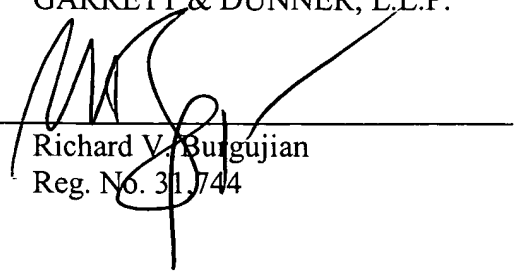
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 10, 2004

By: \_\_\_\_\_

  
Richard V. Burgujian  
Reg. No. 31,744